

## **REMARKS**

The Office Action has maintained the restriction requirement, and has withdrawn from consideration Claims 11-34, 37-61, 64-67 and 69-70. It has examined Claims 1-10, 35, 36, 62, 63 and 68.

Claims 1, 2 and 35 are rejected under 35 U.S.C. §102(a) as defining subject matter which is allegedly anticipated by the teachings in Chang et al in JACS, 2002, 124, 9, 1856-1857 (Chang et al.). The Office Action has further rejected Claims 1-2 and 10 under 35 U.S.C. §102(b) as defining subject matter, which is allegedly anticipated by the teachings in JP-05- 163 203 (“JP ‘203”). Further, the Office Action has rejected Claims 1-2, 35, 62-63 and 68 under 35 U.S.C. §102(b) as defining subject matter, which is allegedly anticipated by the teachings in U.S. Patent No. 4,877,784 to Shroot et al (“Shroot et al”). Finally, the Office Action has objected to Claims 3-9 and 36, but has indicated that the subject matter therein is allowable if rewritten in dependent form.

Applicants have amended the Claims which, when considered with the comments hereinbelow, are deemed to place the present case in condition for allowance. Favorable action is respectfully requested.

At the outset, before addressing the merits of the rejection, it is to be noted that applicants are submitting a machine translation of JP ‘203, and a separate translation of the examples therein. Applicants respectfully request that the translation be made of record in the above-identified application. To that end, applicants are enclosing a PTO 1449 form, which lists the translation of the JP ‘203 application. In the Response, applicants will be referring to the translation of JP ‘203 and translation of the examples in JP ‘203 (hereinafter “Translation”), instead of the Abstract of JP’203, unless indicated otherwise.

Applicants request consideration of the Restriction Requirement earlier imposed in view of the Remarks proffered in the Response dated September 5, 2006, the contents of which are incorporated by reference. Although the Office Action has withdrawn several claims, applicants have not abandoned the subject matter therein, and reserve the right to file a divisional application directed thereto.

Paragraphs 11 and 12 of the specification have been amended consistent with the language of original Claim 1.

Applicants have amended and added claims to the application. Support for the amendment to Claim 1 is found in Paragraph 29 of the instant specification and original Claim 1. The amendment to the definition of  $R_1$  in the specification is supported by the disclosure in Paragraph 14 of the instant specification. Claim 1 has been amended to remove “lower” before alkylene in the definitions of  $R_2$  and  $R_3$ . Support for the amendment to Claim 9 is also found in Paragraph 29 of the instant specification. The amendment to Claim 35 is found in original Claim 35 and Paragraph 29 of the instant specification. Further, Claim 35 has been amended to remove the term “lower” before alkylene in the definitions of  $R_2$  and  $R_3$ .

Claims 71-89 have been added to the application. Support for Claim 71 is found in original Claim 1, and original Paragraphs 12 and Paragraphs 29 of the instant specification. Claim 72 is supported by the disclosure in Paragraph 40. Support for Claims 73 is found in Paragraphs 78-80 of the instant specification.. Support for Claim 74 is found in Paragraph 53-73 and 214 of the instant specification. Support for Claim 75 is found in Paragraph 53 of the instant specification. Support to Claim 86 is found in Paragraph 85 of the instant specification. Applicants have rewritten the subject matter of original Claim 62 in Claims 76-85. Original Claim 10 supports claim 87.

No new matter is added to the specification.

In support of the rejection of Claims 1, 2 and 35, the Office Action cites Chang et al.

Chang et al. disclose various amides; however, it only discloses a single type of tertiary amide on page 1856. Except for the tertiary amide formed from a diamine designated therein as DT, all of the other ceramides described therein are secondary amides, not tertiary amides. The one type of tertiary amide described therein has the two substituents attached to the nitrogen atom of the amido group as being an alkyl group having 14 carbon atoms. As recited in the rejected claims of the present application, the two substituents attached to the nitrogen atom of the amido group are not both a C<sub>14</sub> alkyl group. More specifically, in the tertiary amides recited in the rejected claims, one of the branches attached to the nitrogen group of the amide, designated herein as R<sub>6</sub>, is aryl, aryl lower alkyl, or R<sub>7</sub>. Thus, the tertiary amides recited in Claims 1, 2 and 35 of the present application cannot have two fatty groups on the nitrogen atom wherein both of the groups contain 14 carbon atoms. Thus, the subject matter of Claims 1, 2 and 35 are not described or taught in Chang et al.

Case law has held that anticipation requires that the prior art reference describe every element of the claimed invention, either expressly or inherently, such that a person of ordinary skill in the art could practice the invention without undue experimentation. Atlas Power Co. v. Ireco, Inc., 190 F.3d 1342, 1347, 51 USPQ2d 1943, 1947 (Fed. Cir. 1999) The exclusion of a claimed element from a prior art reference is enough to negate anticipation by the reference. Kalman v. Kimberly-Clark Corp., 713 F.2d 760, 771-772, 218 USPQ781, 789 (Fed. Cir. 1983).

As described above, the claimed invention recited in Claims 1, 2, and 35 does not encompass a tertiary amide described in Chang et al.

Consequently, Chang et al do not anticipate Claims 1, 2 and 35. Withdrawal of this rejection is respectfully requested.

Pursuant to the rejection of Claims 1, 2 and 10 under 35 U.S.C. §102, the Office Action cites JP'203.

However, based on the Translation, the tertiary amides that are described in the Translation have at least two alkyl groups substituted on the nitrogen atom of the amido group. As described in the Translation, the tertiary amide formed have the groups  $R_2'$ ,  $R_3'$  and  $R_4'$  substituted on the nitrogen atom of the amido group, and they can either be alkyl or hydroxyethyl. The subject matter of Claims 1, 2 and 10 does not encompass a tertiary amide whereas both substituents on the amide nitrogen are alkyl or hydroxyalkyl. As defined,  $R_6$  is an aryl, arylalkyl or  $R_7$ , which contains an aryl group; thus  $R_6$  cannot be alkyl or hydroxyalkyl. Thus, the subject matter of Claims 1, 2 and 10 are not described or taught in the Translation. Therefore, the rejection of Claims 1, 2 and 10 under 35 U.S.C. §102(b) is obviated; withdrawal thereof is respectfully requested.

It is to be noted that neither reference specifically discloses distearyl linoleamide. Thus, the subject matter of Claim 87 is not described in Chang et al. or in the Translation.

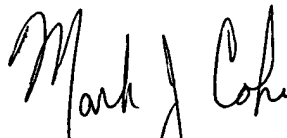
Further, based on the teachings therein, neither Chang et al. nor the Translation teach or disclose a tertiary amide hydrate, the subject matter of Claims 74-86. Thus, neither Chang nor the Translation anticipates the subject matter of Claims 74-86. Further, the subject matter recited in Claims 71-73 does not encompass any saturated alkyl group on the nitrogen atom of the amido group. Therefore, the subject matter of Claims 71-73 is not described in either Chang et al or in the Translation. Thus, neither Chang et al nor the Translation anticipate the subject matter recited in Claims 71-73.

Pursuant to the rejection of Claims 1, 2, 35, 62, 63 and 68 under 35 U.S.C. §102(b), the Office Actions cites Shroot et al.

Shroot discloses tertiary amides wherein the substituent on the acyl carbon atom of the amide has a carbon-carbon triple bond. The subject matter in the rejected claims does not encompass any amides where there is a carbon-carbon triple bond in one of the substituents on the acyl carbon atom or the nitrogen atom of the amide. Thus, Shroot et al. do not anticipate the subject matter of the rejected claims.

Accordingly, in view of the amendments to the Claims and the Remarks hereinabove, it is respectfully submitted that the present application is in condition for allowance, which action is earnestly solicited.

Respectfully submitted,

A handwritten signature in black ink, appearing to read "Mark J. Cohen". The signature is fluid and cursive, with the first name "Mark" and last name "Cohen" clearly distinguishable.

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